

REMARKS**A. Drawings**

In reviewing the present application, Applicants noticed that the specification (page 14, line 26) makes reference to Figures 7A and 7B. Based on the copy of the application maintained in the client's files, it appears that a Figure 7 was included with the patent application, as opposed to a Figure 7A and 7B. Attorneys for applicants have reviewed the patent prosecution files for the assignee of the present invention and have identified that Figures 7A and 7B correspond to figures originally presented in United States Patent Application serial no.09/441,656. Copies of Figures 7A and 7B from that application are attached.

As you will notice, the drawing designated Fig. 7A is identical to drawing filed as Figure 7. It appears that the drawing corresponding to Fig. 7B was not included with the present application. Nevertheless, the present application fully discloses all of the elements in the drawing designated Fig. 7B (page 14, line 26 – page 16, line 20):

With reference to **FIG. 7A and 7B**, a directory assistance center **100** according to a preferred embodiment of the present invention includes a switching matrix platform **114**, also known as a private branch exchange (PBX) or switch, connected to one or more external T1 voice connections **112** and one or more corresponding T1 data connections **113** from caller networks. (The T1 carrier is the most commonly used digital line in the United States, Canada, and Japan. In these countries, it carries 24 pulse code modulation (PCM) signals using time-division multiplexing at an overall rate of 1.544 megabits per second. T1 lines use copper wire and span distances within and between major metropolitan areas. It should be appreciated that other systems may also be used.) Switching matrix platform **114** is also connected via T1 communication links to a channel bank **116** for coupling to a plurality of operator and fulfillment agent telephones **118** and **119** respectively.

Each operator and fulfillment agent is equipped with a terminal 120 and 121 that includes a monitor and keyboard with associated dialing pad. The operator terminals are coupled over a data network 124 to a database server 126, allowing an operator to access the data in database server 126 through the operator terminals 120 and fulfillment agent terminals 121. The database server 126 contains standard telephone directory information.

The data network 124 further connects to a voice response unit (VRU) 130 and a switching matrix host computer 128 (also known as a PBX host), which in turn is connected to the switching matrix platform 114 by switch data link 122. The data network 124 may, but not necessarily, also further connect to a directory listing or concierge database 136 and a caller profile database 134. The caller profile database 134 stores detailed information about a subscriber. Such details may include the subscriber's name, contact details, preferences, dietary requirements, likes and dislikes, past logged activity, etc. The directory listing or concierge database 136 may contain directory listing information on restaurants, events, accommodation, transportation, travel information and booking, stock prices, weather and other services such as grocery or flower delivery, etc.

In one embodiment, the VRU 130, database server 126, and switching matrix host 128 have redundant systems (not shown), which can operate as either back-up systems in the event of primary system failure, or provide load-sharing in either a master-slave or a peer-to-peer relationship with the primary system.

The data network 124 consists of, but is not limited to, a local area network (LAN) 127. The LAN 127 may connect to a plurality of other similar remote LANs 129 to form the WAN 115. The LANs 127 and 129 are connected to one another via routers or other WAN connections 125. The WAN may furthermore be connected by a frame relay connection which is a telecommunication service designed for cost-efficient data transmission for intermittent traffic between local area networks (LANs) and between end-points in a WAN. It should be appreciated by one skilled in the art, that databases 126, 134 and 136 may be located at each LAN or at a single central LAN.

A subscribers mobile or wireless telephone 144 communicates with a wireless telephone network 146 which in turn is connected to a carrier network node 142 and carrier switching center 140.

The T1 voice connections 112, or voice links, provide connection between the directory assistance center's switching matrix platform 114 and the carrier's switching center 140, through which incoming directory assistance calls are received. The T1 voice connections 112 further provide connection to the network over which outgoing calls are placed (which network may be different than that used for incoming traffic). Similarly, T1 data connections 113, or data links, provide a signaling connection between the directory assistance center's node and the carrier's SS7 network node 142, through which incoming and outgoing signaling messages are transmitted (Common Channel Signaling System No. 7 (SS7) is a global standard for telecommunications defined by the International Telecommunication Union (ITU) Telecommunication Standardization Sector (ITU-T). The standard defines the procedures and protocol by which network elements in the public switched telephone network (PSTN) exchange information over a digital signaling network to effect wireless and wireline call setup, routing and control). The directory assistance node is contained within the switching matrix platform 114, but one with skill in the art will appreciate that the directory assistance node could also be a physically distinct component. If the outgoing call is being placed over a different network than that on which the incoming call was received, a second data connection to the outgoing network will be established.

Applicants submit that the drawing corresponding to Fig. 7B is unnecessary for the understanding of the subject matter sought to be patented. The present application is directed to a system and method for providing concierge-like services to individuals who request such services. 35 U.S.C. §113 requires a drawing "where necessary for the understanding of the subject matter patented." Applicants believe that, given disclosure of the patent application including the above-referenced excerpt, Fig. 7B is unnecessary for an understanding of the present system and method for providing concierge-like services.

Applicants amend the specification to delete all references to Figures 7A and 7B and insert references to "Fig. 7" therefor. On a separate sheet accompanying the present amendment, Applicants delete references on Fig. 7 to elements ("A/E" and "B/F") on the unnecessary Fig. 7B.

B. Cancellation of Claim 20

Applicants have cancelled claim 20 in the present application.

C. Rejections Under 35 U.S.C. § 102

Claims 1-5, 7-11, 16, 19, 20, 22-25, 27-32, 35, 37 and 38 stand rejected under 35 U.S.C. § 102(e) as being anticipated by DeLorme et al. (U.S. Patent No. 5,948,040 ("DeLorme")). Regarding claims 1 - 3, 7 - 11, 19, 20, 22 - 25, 27 - 32, and 35, the Examiner generally asserts that DeLorme "teaches having and accessing databases, or a partitioned database, or linkage to third-party databases throughout the requesting/fulfillment process from electronic tickets or variations thereof." (Office Action 7/5/01, p. 2). Regarding claims 4, 5, 16, 37 and 38, the Examiner has asserted that the use of such electronic tickets is inherent in the DeLorme reference.

Applicants respectfully disagree. DeLorme fails to disclose, teach or suggest the generation of such an electronic ticket by a receiving service agent as required by claims 1-18, 35-38. DeLorme does not disclose fulfillment agents as claimed in the present invention. It also fails to disclose, teach or suggest the use of an electronic ticket with information pertinent to the request for concierge services in fulfilling that request as required by claims 1-18, 20, 35-38.

The DeLorme System Does Not Disclose The Generation of An Electronic Ticket by A Service Agent

The DeLorme system requires the user to interact with the TRIPS system and possibly any third party provider from the start of the request until the desired results are output by the TRIPS system. (Col. 73:18 – 29). The preferred embodiment of the TRIPS invention is for a home user connecting to the TRIPS system by a desktop PC where they can navigate various sections of the TRIPS system and continue to define and refine the search until the desired output is generated. (Col. 13: 44 – Col. 14:43; Col. 15:14-). Specifically, DeLorme teaches that the main advantage of the TRIPS invention over the prior art is that it allows users to customize their travel plans to suit their personal interests and needs. This emphasis on customized planning means that the user remains in control with respect to the fulfillment process by selecting from displayed options to customize their travel plans. Col. 73:18 – 29.

By contrast, the present invention requires that the user interact with the receiving agent at the beginning of the process to provide the necessary information to generate an electronic ticket. It is a significant and true advantage of the present invention that the receiving agent, rather than the user, creates the electronic ticket and interacts with the networked databases. See e.g., claim 1 (“an electronic ticket generated by a receiving agent having information associated with the request for concierge-like services); see also, amended claims 19 and 35. This means that the user need not remain involved in the transmission of said information via the electronic ticket to the fulfillment agent. This drastically reduces the involvement of the user in the fulfillment process and therefore, the amount of time he/she has to use in placing the request.

Further, the fulfillment agent does not require further input of the user (e.g., in selecting among options) to fulfill the request. "The intent of the interface is that the ticket can be filled by the fulfillment agent without further interaction between the system and the calling customer." (Specification, page 8, lines 17 – 23) This distinction is particularly useful when a traveler is in a remote location or en route to a destination. The information in the electronic ticket triggers the transmission of the request to an appropriate fulfillment agent who fulfills the request without requiring further input from the user.

These are all significant advantages that are not expressly or inherently disclosed or suggested by DeLorme et al. Because the cited reference does not disclose, teach or suggest, expressly or inherently, the use of electronic tickets containing information pertinent to the request for concierge-like services, or the generation of such an electronic ticket by a receiving agent, claims 1 - 5, 7 - 11, 19, 22-25, 27 - 32, 35, 37 and 38 are not anticipated and are patentable over DeLorme et al.

DeLorme Does Not Disclose the Use of Fulfillment Agents As Claimed

Claims 1 - 34 are patentable over DeLorme because DeLorme does not disclose, teach or suggest a fulfillment agent as claimed by the present invention. The TRIPS system in DeLorme teaches a system in which the user inputs data regarding a travel-planning request into the TRIPS database which searches for information relating to the request and provides output. The request is processed by the TRIPS system. No fulfillment agent is disclosed, taught or suggested.

In contrast, as claimed in the present application, fulfillment agents access the electronic tickets generated by the receiving agent and use the information contained therein to fulfill the request for concierge-like services. Each request is processed by a fulfillment

agent. Unlike the DeLorme invention, there is both a receiving agent and a fulfillment agent and a communication path therebetween.

Because the cited reference does not disclose, teach or suggest, expressly or inherently, the involvement of a fulfillment agent in the fulfillment of each request, claims 1 – 34 are not anticipated and are patentable over DeLorme et al.

DeLorme Does Not Disclose The Use of Electronic Tickets Having Information Associated With Request for Concierge-Like Services In Fulfilling Such Requests

Claims 1, 19 and 35 are patentable over DeLorme because DeLorme does not describe a system or method wherein an electronic ticket containing information relating to a request for concierge-like services is used to fulfill the request. DeLorme is directed towards a trip reservation information and planning system (TRIPS) which allows user to make travel plans via requests made to and processed by the TRIPS system without use of electronic tickets. The only use of tickets (either electronic or printed) is as output reflecting the intermediate or completed travel plan “to aid the traveler en route.” (Col. 15:14 – Col. 16:18). The DeLorme et al. reference makes no reference to the use of the tickets in the manner disclosed by the Teleconciierge invention.

The use of electronic tickets in the Teleconciierge invention is novel, useful and very different from anything disclosed in DeLorme et al. The invention is concerned specifically with the generation of an electronic ticket that does not simply reflect the result of the completed request, but rather contains information relating to the request which facilitates the fulfillment of requests for concierge-like services and drastically reduces the effort required of the user of the system. The receiving agent generates the ticket as a repository of all the information relating to the request, not as a record of the completed/fulfilled request.

(Specification, page 8, lines 17 – 23) Unlike the TRIPS system, the ticket that is generated allows fulfillment of the request by agents who have not necessarily interacted with the user.

Regarding claims 4, 5, 16, 37 and 38, the Examiner has asserted that the use of such electronic tickets is inherent in the DeLorme reference. The Applicant respectfully disagrees. Regarding inherency, the evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skilled.” *Continental Can Co. v. Monsanto Co.*, 948 F. 2d 1264, 1268 (Fed. Cir. 1991). The fact that a prior art reference is capable of being modified to arrive at the invention is not sufficient to support anticipation based on inherency. *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999).

The use of electronic tickets disclosed in DeLorme is very different from the use disclosed by the Teleconciierge invention. DeLorme teaches the uses of tickets as output from the TRIPS travel planning system and would typically include the result of the user’s planning session. (Col. 18:40 – 57). The Teleconciierge invention specifically gathers information related to the request at the beginning of the process and uses it in a substantially different way than the TRIPS system.

D. Rejections Under 35 U.S.C. § 103

Claims 6, 12-15, 17, 18, 21, and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over DeLorme et al. DeLorme et al. has been discussed above. Applicants respectfully submit that the Examiner has not met the burden of establishing obviousness under § 103. A rejection under § 103 requires not only express support, but also that the Examiner makes a specific showing of where the suggestion or motivation is found in the art to make the modification. *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998; *Heidelberger*

Druckmaschinen v. Hantscho Commercial, 21 F.3d 1068, 1072 (Fed. Cir. 1994); *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987).

Regarding claims 6, 13-15, 21 and 33, the Examiner has generally asserted that the use of separate pools of agents and prioritization of requests and fulfillment are obvious to one skilled in the art. The Examiner provides no basis or support for why these elements are obvious. Applicants traverse the rejection on the grounds that these claims depend on independent claims 1 and 19. As explained above, several features of claims 1 and 19 are not disclosed, and are not taught or suggested in DeLorme. Therefore, claims 6, 13-15, 21, and 33, including those limitations cannot be considered obvious over DeLorme. It is therefore respectfully requested that the rejection on these grounds be withdrawn.

Regarding claims 12 and 34, the Examiner has generally asserted that the use of an alarm that alerts agents is well known in the art and that it is inherent in the invention of DeLorme. The Examiner provides no basis or support for why these elements are obvious or inherent. Applicants traverse the rejection on the grounds that these claims depend on independent claims 1 and 19, respectively. As explained above, several features of claims 1 and 19 are not disclosed, and are not taught or suggested in DeLorme. Therefore, claims 12 and 34, including those limitations cannot be considered obvious over DeLorme. Moreover, as discussed above, unsupported statements as to the obviousness of a claim over a cited reference are insufficient. The Examiner must specifically point out where the suggestion or motivation is found in the art to make the proposed modification. It is therefore respectfully requested that the rejection on these grounds be withdrawn.

Regarding claims 17 and 18, the Examiner has generally asserted that they include obvious design choice that may be inherent in DeLorme. The Examiner provides no basis or

support for why these elements are obvious or inherent. Applicants traverse the rejection on the grounds that these claims depend on independent claim 1. As explained above, several features of claim 1 are not disclosed, and are not taught or suggested in DeLorme. Therefore, claims 17 and 18, including those limitations cannot be considered obvious over DeLorme. Moreover, as discussed above, unsupported statements as to the obviousness of a claim over a cited reference are insufficient. The Examiner must specifically point out where the suggestion or motivation is found in the art to make the proposed modification. It is therefore respectfully requested that the rejection on these grounds be withdrawn.

Regarding claim 26, the Examiner has generally asserted that the transmission or fulfillment of requests via fax "would be obvious to one skilled in the art in lieu of all the aforementioned modes of operation in the invention of DeLorme et al." (Office Action 7/5/2001, page 14). The Examiner provides no basis or support for why this element is obvious. Applicants traverse the rejection on the grounds that this claim depends on independent claim 19. As explained above, several features of claim 19 are not disclosed, and are not taught or suggested in DeLorme. Therefore, claims 12 and 34, including those limitations cannot be considered obvious over DeLorme. Moreover, as discussed above, unsupported statements as to the obviousness of a claim over a cited reference are insufficient. The Examiner must specifically point out where the suggestion or motivation is found in the art to make the proposed modification. It is therefore respectfully requested that the rejection on these grounds be withdrawn.

Regarding claim 36, the Examiner has generally asserted that it would be obvious to one skilled in the art to imprint the time of the next action on an electronic ticket and may be inherent in DeLorme. The Examiner provides no basis or support for why this element is

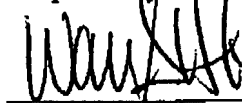
obvious or inherent. Applicants traverse the rejection on the grounds that this claim depends on independent claim 35. As explained above, several features of claim 35 are not disclosed, and are not taught or suggested in DeLorme. Therefore, claim 36, including those limitations cannot be considered obvious over DeLorme. Moreover, as discussed above, unsupported statements as to the obviousness of a claim over a cited reference are insufficient. The Examiner must specifically point out where the suggestion or motivation is found in the art to make the proposed modification. It is therefore respectfully requested that the rejection on these grounds be withdrawn

E. Conclusion

Applicants assert that all of the rejections based upon DeLorme have been traversed. If prosecution of this application can be expedited through a telephone interview, the Examiner is invited to call the undersigned attorney at the number below. Otherwise, early notification of allowance of these claims is earnestly requested.

Dated: November 5, 2001

Respectfully submitted,



Warren Heit (Reg. No. 36,828)

White & Case LLP
1155 Avenue of the Americas
New York, NY 10036-2787
(650) 213-0321

Version of Claims with Markings:

19. (Amended) A method for providing concierge-like services comprising the steps of:

connecting a communication from a user to a service agent;

receiving by a service agent a request for concierge-like services;

generating by the service agent a ticket associated with the request for concierge-like services;

presenting the request to a service agent for fulfillment;

fulfilling by the fulfillment agent the request for concierge-like services; and
communicating the fulfillment of the request.

35. (Amended) An electronic ticket used in fulfilling a request for concierge-like services comprising:

a first field into which data concerning a user's contact information is input by an agent receiving such information from the user;

a second field into which information concerning the request for concierge-like services is input by said agent receiving such information from the user; and

a third field into which an identifier of the locale where concierge-like services are requested is input by said agent receiving such information from the user.